

REMARKS

The Examiner objected to the oath/declaration as being defective for not identifying the citizenship of each inventor and for lacking a post office address for each inventor. In response, enclosed herewith is a Supplemental Declaration.

Claims 5, 6 and 32 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants respectfully traverse this rejection.

Applicants have amended the claims in the manner suggested by the Examiner. Accordingly, withdrawal of this §112 rejection is respectfully requested.

Claims 1, 7, 19-23, 26-30, 32 and 33 stand rejected under 35 U.S.C. §102(b) as being anticipated by German Reference No. 3737993 to Engelbrech. Applicants have cancelled Claim 27, without prejudice, thereby rendering this rejection moot with respect to this claim. However, with respect to Claims 1, 7, 19-23, 26, 28-30, 32, and 33, Applicants respectfully traverse this rejection.

Applicants respectfully submit that the Engelbrech reference fails to disclose all of the features of the present invention. More specifically, the Engelbrech reference fails to disclose a measuring guide that includes, *inter alia*, “a locking mechanism that cooperates with the ruler to permit selective adjustment of the distance between the marking guide and the stop plate by moving the stop plate with respect to the ruler” (emphasis added), as defined in independent Claim 1. Additionally, the Engelbrech reference also fails to disclose a method for utilizing a measuring device that includes, *inter alia*, a step of “setting a selected

distance between a noninvasive stop plate and a noninvasive marking guide movably coupled to the stop plate, wherein setting comprises changing the position of the noninvasive stop plate relative to the noninvasive marking guide along a ruler by moving the noninvasive stop plate with respect to the ruler” (emphasis added), as defined in independent Claim 19. Finally, the Engelbrech reference also fails to disclose the system of independent Claim 30 that includes, *inter alia*, “means for controlling the distance between the end of the desired bone member and a location to be marked by moving the means for abutting with respect to the ruler” (emphasis added).

One example of an embodiment of the present invention defined in independent Claim 1 is shown in Figures 1 and 2, and includes a marking guide 24, a stop plate 30, a ruler 22, and a locking mechanism 26. The locking mechanism 26 cooperates with the ruler 22 to permit selective adjustment of the distance between the marking guide 24 and the stop plate 30 by moving the stop plate with respect to the ruler, as defined in independent Claim 1. Similarly, the method of Claim 19 may also be implemented with the embodiment of Figures 1 and 2 by setting a selected distance between noninvasive stop plate 30 and noninvasive marking guide 24, where the setting step includes changing the position of noninvasive stop plate 30 relative to noninvasive marking guide 24 along ruler 22 by moving the noninvasive stop plate with respect to the ruler. Finally, one example of the system defined in Claim 30 is shown in use in Figure 14, which includes means for controlling 26 the distance between end 150 (Figure 14) of bone member 152 and a location to be marked 154 by moving the means for abutting 30 with respect to ruler 22.

In contrast, the device of the Engelbrech reference lacks a feature in which a stop plate (or a means for abutting) is moved with respect to the ruler. Instead, as shown in Figures 1 and 2 of the Engelbrech reference, the support 3 (which is the feature that most closely resembles the claimed stop plate) is rigidly fixed to the ruler 2. Thus, support 3 does not move with respect to ruler 2. Accordingly, as all of the features of independent Claims 1, 19 and 30 are not disclosed in the Engelbrech reference, Applicants respectfully request the withdrawal of this §102(b) rejection of independent Claims 1, 19 and 30, and associated dependent Claims 7, 21-23, 26, 28, 29, 32 and 33.

Claims 2-6, 10-18, 24, 25 and 31 stand rejected under 35 U.S.C. §103 as being unpatentable over Engelbrech in view of United States Patent No. 4,893,619 to Dale et al. Applicants respectfully traverse this rejection.

Claims 2-6, 24, 25 and 31 all depend, directly or indirectly, from independent Claim 1 or from independent Claim 19 or from independent Claim 30, and therefore include all of the features of either Claim 1, Claim 19, or Claim 30, plus additional features. Accordingly, Applicants respectfully request that the §103 rejection of dependent Claims 2-6, 24, 25 and 31 under Engelbrech in view of Dale et al. be withdrawn considering the above remarks directed to independent Claims 1, 19 and 30 when responding to the §102(b) rejection of these claims.

With respect to independent Claim 10 and associated dependent Claims 11-18, Applicants respectfully submit that the cited references fail to disclose or suggest the claimed stop plate that is pivotable with respect to the ruler to facilitate transverse placement, with

respect to the ruler, against an end surface of a bone, as defined in independent Claim 10. As correctly acknowledged by the Examiner, the Engelbrech reference fails to disclose the claimed pivotable stop plate. *See* March 25, 2004 Office Action, page 5, paragraph 12, lines 2-4. To remedy this deficiency, the Examiner relied upon the Dale et al. reference. However, Applicants respectfully submit that one of ordinary skill in the art would not have been motivated to modify the device of Engelbrech in light of the Dale et al. reference to arrive at the claimed invention of Claim 10, which includes the stop plate that is pivotable to facilitate transverse placement of the stop plate, with respect to the ruler, against an end surface of a bone, as defined in independent Claim 10.

In the device of Dale et al. the Examiner equated arms 70, 140 and 150 with the claimed stop plate. However, members 70, 140 and 150 are not configured for transverse placement, with respect to a ruler, against an end surface of a bone. On the contrary, members 70, 140 and 150 are configured to be placed on the side surfaces of a bone, as shown in Figure 8 of Dale et al.

Applicants respectfully submit that, assuming *arguendo* that Dale et al. could be combined with the Engelbrech reference in the first place, one of ordinary skill in the art would have taken the entire assembly from Dale et al. (including members 70, 140 and 150), and would have substituted that assembly for support 3 of Engelbrech. Accordingly, such a combination lacks the claimed stop plate that is pivotable “to facilitate transverse placement, with respect to the ruler, against an end surface of a bone,” as defined in independent Claim

10. Thus, Applicants respectfully request the withdrawal of this §103 rejection of independent Claim 10 and associated dependent Claims 11-18.

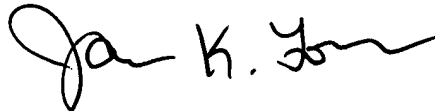
Applicants have also added new dependent Claims 34 and 35, which Applicants respectfully submit are also allowable for at least the reasons discussed above with respect to the allowability of associated independent Claims 1 and 10.

For all of the above reasons, Applicants request reconsideration and allowance of the claimed invention. Should the Examiner be of the opinion that a telephone conference would aid in the prosecution of the application, or that outstanding issues exist, the Examiner is invited to contact the undersigned.

Respectfully submitted,

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